

REMARKS

Status of the Claims

Claims 1, 22, 24-26 and 29 are pending in the application, and claims 2-21, 23, 27, 28 and 30-40 have been withdrawn in accordance with the Examiner's restriction requirement. All of the pending claims stand rejected.

Claim Amendments

Claim 1 is hereby cancelled.

Comments Regarding the Restriction

With respect to the Restriction, the Examiner states at Office Action page 2, paragraph 2, that "Election was made without traverse in Paper No. 10." The Applicant first notes that the assignment of numbers to application papers is a process that occurs internally within the Patent and Trademark Office, and the Applicant has no ready method of ascertaining what any particular "Paper No." is. This is particularly true in this case because the Applicant has filed two separate replies to the Restriction Requirement. As such, it is unknown whether "Paper No. 10" is the first reply dated June 30, 2003, or the second reply dated August 26, 2003. The Applicant respectfully requests that the Examiner provide the title and date of any application papers to which the Examiner may cite in future correspondences to facilitate clear communication.

Second, the Applicant notes that the Examiner's allegation that the Applicant elected without traverse in any previous paper is incorrect. The Applicant traversed the restriction requirement in the June 30, 2003 reply, then incorporated this traverse by reference into the August 26, 2003 reply. Furthermore, the Examiner states in paragraph 1 of the office action that "Applicant's election with traverse of VI in Paper No. 10 is acknowledged." As such, it is unclear whether the Examiner believes that the Applicant did or did not traverse the restriction. Clarification is respectfully requested.

Claim Rejections

The Examiner rejected claims 1, 22, 26 and 29 as being unpatentable over Lobash *et al.* (U.S. Pat. No. 5,425,217), and rejected claims 24 and 25 as being unpatentable over Lobash in view of Östberg (U.S. Pat. No. 4,416,312). Three criteria must be met to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2142 *et seq.* The Applicant respectfully submits that the prior art of record, regardless of whether it is properly combined, fails to teach or suggest all of the features of the claims, and therefore there is no *prima facie* case of obviousness.

With regard to claim 22, the Examiner alleges that "Lobash...teaches that the air applicator includes a guide plate 18, an open passage 12 having an upstream end and a downstream end opposite the upstream end, and one or more orifices 36 adapted to direct airflow towards the downstream end." Office Action p. 3. However, Lobash fails to show or suggest the feature recited in claim 22 of an "external air applicator." An "external" air applicator is defined in the present Specification as one that has a conveyance passage that is not enclosed. *See, e.g.,* Specification p. 15, ll. 7-10 ("External air applicators 500, in contrast with internal air applicators 100, do not have a substantially enclosed passage 104 for conveying the parts 118. Instead, external air applicators 500 use an open passage that is defined, at least on one side, by a guide plate 502."). This claimed feature is shown graphically in the embodiments of Figures 5, 6, 7, 8, 9, 12 and 13, which show guide plates upon which the parts are conveyed, but does not show a corresponding plate on the opposite side of the air flow to physically contain the parts.

In contrast, Lobash shows a device having what it describes as a "generally closed tunnel." Lobash col. 2, ll. 30-31. This "tunnel," which is shown clearly in Lobash

Figure 4, consists of a channel 14 having first and second vertical side plates 16 that extend upwards from a center plate 18. *Id.* at col. 3, ll. 27-30. A cover 48 closes off the top of the channel 14 to form "a generally closed envelope or tunnel having an open infeed end and an open outfeed end." *Id.* at col. 4, ll. 48-52. As such, Lobash fails to disclose or reasonably suggest an "external air applicator," as recited in claim 22 of the present invention, and thus fails to teach or suggest all the limitations of claim 22. For at least this reason, there can be no *prima facie* case of obviousness, and the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 22.

With respect to claim 29, the Examiner alleges that Lobash teaches...a regulator adapted to control properties of the airflow. A regulator inherently controls the airflow that flows into air jets 36." A rejection based on inherency requires that "the missing descriptive matter is necessarily present in the thing described in the reference....Inherency may not be established by probabilities and possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). The Applicant respectfully submits that Lobash fails to inherently disclose the use of a regulator.

Although Lobash does disclose air jets 36 receiving air at a pressure of 10-15 psi, *see* Lobash col. 4, ll. 16-20, Lobash fails to disclose how this range of pressures can be achieved, and says nothing about an air regulator. It is true that a regulator, which is a device that reduces high pressure air in a controlled manner by passing it through an orifice, could be used to provide the desired pressures in Lobash. However, it is just as possible to provide the different pressures identified in Lobash by using a controllable air compressor to pressurize ambient air (*i.e.* unpressurized air) to the desired pressure. It would also be possible to connect a high pressure source to the air jets 36, and control the pressure by selectively opening bleed valves that allow a certain amount of the high pressure air to vent into the atmosphere. Because it is just as likely that any of these three alternatives can be used to obtain the pressures described in Lobash, it can only be said that the use of a regulator *may* result from the set of

circumstances described in Lobash. According to the controlling case law cited above, this is insufficient grounds for an inherency rejection. For this additional reason, the Applicant respectfully requests reconsideration and allowance of claim 29.

With respect to remaining claims 24-26, these claims depend from claim 22, and therefore the above rationale applies to traverse the Examiner's rejections as they are set forth in the Office Action. As such, reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

For at least the above reasons, the Applicant respectfully submits that the application is in condition for allowance, and favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

Respectfully submitted,
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